

IN THE CLAIMS:

Please amend claim 63 as follows:

E/ 63. (Amended) An isolated nucleic acid molecule comprising a nucleic acid selected from the group consisting of

- (a) a nucleotide sequence that has at least 60% sequence homology with respect to the nucleotide sequence of SEQ ID NO: 2; and
- (b) a nucleotide sequence that has at least 60% sequence homology with respect to the nucleotide sequence of SEQ ID NO: 3;

that encodes a polypeptide that binds transferrin when the nucleotide is transfected into a cell that lacks transferrin receptors and the cell is incubated with 5 µg/ml of transferrin in nutrient media for 30 min on ice.

REMARKS

Applicants note that the Office Action was sent by mail to an incorrect law firm, although all previous correspondence was correctly forwarded to the Applicants' Attorneys of record. The Applicants request that the Examiner forward all future correspondence to its Attorney of record, Richard H. Zaitlen, Esq., at the address indicated below.

Applicants have studied the Office Action of April 8, 2002 ("Office Action"), and Attorney for Applicants conducted a telephone conference with the Examiner on July 11, 2002 with regard to the same. In that telephone conference, the Examiner made several suggestions as to how Applicants may obviate the rejections set forth in the Office Action. Specifically, the Examiner indicated that the inclusion of a minimum number of nucleic acids that define the term "complementary" in claim 58 may render that claim allowable, and that the inclusion of either a minimum percentage for sequence homology or specific hybridization conditions may render claim 63 and the claims that depend therefrom allowable.

Pursuant to the telephone conference with the Examiner, the Applicants have amended the claims. It is respectfully submitted that the application, as amended, is in

condition for allowance. Claims 12-18, 20-23, 43-58 and 60-70 are pending in the present application. The applicants have amended claim 63. No new matter has been added. Reconsideration and allowance of the claims in view of the foregoing amendment and the ensuing remarks are respectfully requested.

The Applicants thank the Examiner for allowing claims 43-57 and 60-62.

Attached hereto is a marked-up version of the changes made to the claims and Specification by the current Amendment. The attached page is captioned "Version with Markings to Show Changes Made."

Claim 63, as amended, describes an isolated nucleic acid molecule comprising a nucleotide sequence that has *"at least 60% sequence homology with respect to"* the nucleotide sequences of Applicants' SEQ ID NO: 2 or SEQ ID NO: 3. Support for this amendment may be found in the Specification at page 9, lines 8-10.

Although claims 63-70 had been summarily allowed in the previous office action of December 26, 2001, the Examiner has now rejected claims 63-70 under a rationale identical to that asserted a still earlier office action, dated September 5, 2001. In the present Office Action, the Examiner has once again rejected claims 63-70 under 35 U.S.C. § 112, second paragraph, stating that *"the term 'substantially' in claim 63 is a relative term which renders the claim indefinite,"* and has once again further rejected claims 63-70 under 35 U.S.C § 112, first paragraph, stating that the specification *"does not reasonably provide enablement for a nucleotide sequence consisting of substantially the same nucleotide sequence of SEQ ID NO: 2 and SEQ. ID. NO. 3."*

With respect to 35 U.S.C. § 112, second paragraph, the Applicants respectfully maintain that the terms "substantially similar" are definite terms, that the specification provides explicit guidance as to what the terms mean, and that those of ordinary skill in the art would fully and readily understand them. The Applicants also respectfully maintain that, with respect to 35 U.S.C. § 112, first paragraph, those of ordinary skill in the art will have to execute no more than routine steps – all of which the specification describes in many pages of detail – to identify and use nucleic acid sequences which are "substantially similar" to the sequences identified in the specification.

However, as amended, claim 63 no longer includes the language "substantially similar," and instead describes an isolated nucleic acid molecule comprising a nucleotide sequence that has *"at least 60% sequence homology with respect to"*

(emphasis added) the nucleotide sequences of Applicants' SEQ ID NO: 2 or SEQ ID NO: 3, as per the Examiner's suggestion. On these grounds, the Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 112, first and second paragraph.

Next, although claim 58 was summarily allowed in the previous two office actions of December 26, 2001 and September 5, 2001, in the present Office Action the Examiner has now rejected claim 58 under 35 U.S.C. § 112, second paragraph, stating, *"claim 58 is vague and indefinite because [it] is unclear if the mRNA is complementary to the whole length of SEQ ID NO: 2 or 3, or merely to a portion of it."*

Aside from the fact that this claim was previously allowed in two office actions, the Applicants do not understand the basis of this rejection. The proposition that a claim should be rendered indefinite for use of the term "complementary" when describing the relationship between mRNA and the DNA which it encodes does not seem appropriate. The term "complementary" has a standard meaning that is well known to those of skill in the art; notably, this field of art is one where the level of skill is high. Moreover, the term has an appreciable plain meaning, as it is commonly used and defined in standard textbooks and numerous dictionaries. Applicants respectfully assert that such a plain meaning of "complementary" is sufficient to comport with the requirements of 35 U.S.C. § 112, second paragraph, and respectfully request that the Examiner reconsider and withdraw this rejection on these grounds.

For the foregoing reasons, the Applicants believe that the application is condition for allowance, and respectfully request early, favorable action on the merits. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles telephone number (213) 488-7100 to discuss the steps necessary for placing the application in

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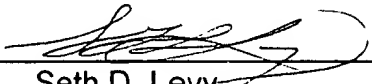
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condition for allowance should the Examiner believe that such a telephone conference would advance prosecution of the application.

Respectfully submitted,

PILLSBURY WINTHROP LLP

Date: July 12, 2002

By: 
Seth D. Levy
Registration No. 44,869
Attorney for Applicants

Enclosure: Petition for One Month Extension of Time

Please forward all correspondence to:

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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The Applicants have amended claim 63 as follows:

63. (Amended) An isolated nucleic acid molecule comprising a nucleic acid selected from the group consisting of

- (a) a nucleotide sequence that has at least 60% sequence homology with respect to the [consisting of substantially the same] nucleotide sequence of SEQ ID NO: 2; and
- (b) a nucleotide sequence that has at least 60% sequence homology with respect to the [consisting of substantially the same] nucleotide sequence of SEQ ID NO: 3;

that encodes a polypeptide that binds transferrin when the nucleotide is transfected into a cell that lacks transferrin receptors and the cell is incubated with 5 µg/ml of transferrin in nutrient media for 30 min on ice.